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EXAMINER
NGUYEN, DUSTIN

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GAVIN BREBNER

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Appeal 2008-005519
Application 09/765,067
Technology Center 2400

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Decided:[1] June 12, 2009

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Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

    Appellant appeals the Examiner's final rejection of claims 1-25 under

35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

We affirm-in-part.

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[1] The two month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date
shown on this page of the decision. The time period does not run from the
Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

A. INVENTION

According to Appellant, the invention relates to a communications system, and to a process for facilitating a transaction between a user and a remote server (Spec. 1, ll. 8-9).

B. ILLUSTRATIVE CLAIM

Claims 1 and 16 are exemplary and are reproduced below:

1.   Process for assisting a transaction between a[sic] user and at least one remote server, the one[sic] each remote server being prepared to process at least one predetermined command, said process comprising:

        receiving an abstract request formulated at a client computer and containing incomplete information identifying a potential transaction;

        analysing said abstract request and mapping it to a corresponding one of said remote servers, and to one of said predetermined command;

        constructing an aggregated request based on said mapped command, enriched with data extracted from a local profile;

        transmitting said aggregated request to said corresponding server;

        receiving the answer from said corresponding server and displaying the answer to the user for completing the transaction.

16. A method of using DMI or WMI interfaces for collecting data representative of a computer profile for achieving an electronic business transaction.

C. REJECTIONS

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Warwick	US 6,598,169 B1	Jul. 22, 2003
Anderson	US 6,578,142 B1	Jun. 10, 2003
Christianson	US 6,102,969	Aug. 15, 2000

Claims 1-4, 6-15, 17-21, and 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of the Anderson in view of Christianson.

Claims 5, 16, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of the Anderson in view of Christianson and Warwick.

The rejection of claims 2, 11-15, and 17 under 35 U.S.C. § 112 has been withdrawn.

II. ISSUES

Has Appellant shown that the Examiner erred in finding that 1) the combination of Anderson and Christianson teaches or would have suggested "receiving an abstract request" which contain "incomplete information identifying a potential transaction" (Claim 1), and 2) the combination of

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Anderson, Christianson, and Warwick teaches or would have suggested a method "of using DMI or WMI interfaces" (Claim 16)?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Christianson

1. Christianson discloses receiving a user query, retrieving a description of each information source, formatting the query according to this description in a manner suitable for each information source, and transmitting the formatted query to the source (col. 3, ll. 8-21).

2. An aggregation engine receives the user query from the user interface module, retrieves wrappers from the wrapper database, and translates the query to the request formats accepted by each of the information sources (col. 8, ll. 25-34; Fig. 3).

Warwick

3. Warwick discloses a Windows Management Instrumentation ("WMI") system which provides an interface through which instrumented components can provide information (Abstract).

IV. PRINCIPLES OF LAW

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d

1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

"An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *see also Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

The Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be

obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 550 U.S. at 418-19).

V. ANALYSIS
Claims 1-4, 6-9, 11-15, 17-21, and 23-25

Appellant provides the same arguments with respect to the rejection of claims 1-4, 6-9, 11-15, 17-21, and 23-25. Therefore, we select independent claim 1 as being representative of these claims. 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that "there is nothing in these pages [referenced by the Examiner], nor indeed in any other passage in Christianson, that may be understood as disclosing and receiving of an abstract request formulated at a client computer" because "'[a]bstract request' . . . refers to a request for a transaction that only contains 'some basic incomplete information' or 'only partial information' for completing the requested transaction" (App. Br. 7).

In the Answer, the Examiner directs the Appellant's attention to Christianson, which the Examiner finds as disclosing:

> The local agent includes means for receiving an abstract request that is entered by a user, that is to say a request that is assumed to contain only partial information that is needed regarding the particular service that is desired. The local agent has access to a list of servers and includes means for analysing that abstract request and for mapping it to one corresponding server, and one particular command for accessing that server. The local agent then constructs an aggregated request transaction based on that particular command, and which further includes the additional information that the agent extract form a local profile. This results in an aggregate request that is transmitted through the network to the identified mapped server.

(Ans. 9-10).

Thus, we determine in this Appeal whether Appellant has shown that the Examiner erred in finding that the combination of Anderson and Christianson teaches or would have suggested "receiving an abstract request" which contains "incomplete information identifying a potential transaction" (Claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio,* 381 F.3d at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns,* 988 F.2d at 1184. Though Appellant argues that the claimed "abstract request" refers to a request "that *only* contains '*some basic* incomplete information' or 'only partial information' *for completing the requested transaction*" (App. Br. 7, emphasis added), such argument is not commensurate with the language of claim 1. Appellant's claim 1 does not place any limitation or context on what the term "abstract request" means, includes, or represents other than that it contains "incomplete information identifying a potential transaction." In fact, claim 1 does not place any limitation on the term "incomplete." Thus, we will not limit the "abstract request" of claim 1 to a request that *only* contains *some basic* incomplete information *for completing the requested transaction*, as Appellant argues. Instead, we interpret claim 1 as requiring an abstract request containing information for identifying a potential transaction, wherein the information is "incomplete," i.e., not whole.

Christianson discloses formatting a query according to this description in a manner suitable for each information source (FF 1), wherein an aggregation engine retrieves wrappers from the wrapper database and translates the query to the request formats accepted by each of the information sources (FF 2). As the Examiner found and as the Appellant admits, the netbot of Christianson adds "additional information from the

wrapper module to the query before forwarding to the information sources" (App. Br. 7).

We find that an artisan would have understood that such query to be aggregated to the accepted formats to be a query containing incomplete information. That is, prior to the aggregation, the query does not have the additional information, and thus, contains incomplete information. Thus, we find that the combined teachings of Anderson and Christianson would have suggested an abstract request containing information for identifying a potential transaction, wherein the information is "incomplete," as required by claim 1.

Appellant further contends that "[t]he Examiner . . . ignores Applicant's argument and does not even allege that, much less cite to a specific portion of the specification where Christianson actually teaches, receiving an abstract request that contains incomplete information identifying a potential transaction" (App. Br. 8). Appellant appears to be repeating the argument that claim 1 recites an "abstract request" that "only" contains information "for completing the requested transaction," which is not commensurate with the language of claim 1. That is, the language of claim 1 does not require any "completing the requested transaction" as Appellant argues.

As discussed above, we interpret claim 1 as requiring an abstract request containing information for identifying a potential transaction, wherein the information is incomplete. We find that the combined teachings of Anderson and Christianson would have suggested an abstract request

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containing information for identifying a potential transaction, wherein the information is "incomplete," as required by claim 1.

Furthermore, we agree with the Examiner's finding that Christianson's query is formatted "according to the description in a manner suitable for each information source" or is translated "into the request formats accepted by each of the N information sources," thereby the query is an "abstract request containing incomplete information identifying a potential transaction" (Ans. 11). That is, even if claim 1 requires information be "for completing the requested transaction" as Appellant contends, we find that it would have understood by skilled artisans that the additional information aggregated to the request for formatting the request in a manner suitable for the information sources would have been information for completing the requested transaction. An artisan would have understood that formatting in the manner that is suitable for the information sources was needed for completing the transaction.

Thus, we agree with the Examiner that the combination of Anderson and Christianson would have fairly suggested "receiving an abstract request" which contains "incomplete information identifying a potential transaction" (Claim 1). Accordingly, Appellant has not shown that the Examiner erred in finding that the combined teachings of Anderson and Christianson would have suggested the invention as recited in independent claim 1. Claims 2-4, 6-9, 11-15, 17-21, and 23-25 fall with claim 1.

Claim 10

As to claim 10, Appellant surmises that "the Examiner is . . . alleging that a 'detecting module for determining available bandwidth' teaches 'detecting a condition of insufficient resources'" (App. Br. 8). Thus, Appellant contends that "available bandwidth" is not the same as "insufficient resources" (*id.*).

In response, the Examiner adds the new finding that, in Anderson, "the content is sent to the user computer, the content includes a summary of information such as the availability of patches and fixes" (Ans. 11). The Examiner then reasons that notifying users "of relevant software updates and upgrades" is "detecting a condition of insufficient resources" (Ans. 11-12).

After reviewing the record on appeal, we agree with the Examiner that an artisan would have understood Anderson's teaching of notifying users of relevant software updates and upgrades to be "detecting a condition of insufficient resources," as set forth in the Examiner's finding. However, claim 10 requires that "in response to said insufficient resources detection, automatically identifying one predetermined server." That is, claim 10 defines "a condition of insufficient resources" to be a condition responsive to which the predetermined server is automatically identified.

In the section relied by the Examiner for the teaching of notifying users of relevant software updates and upgrades, there is no teaching of automatically identifying one predetermined server in response to the notification information.

Thus, though we agree with the Examiner that it would have been obvious to an artisan that the condition in need of updates and upgrades is a condition of insufficient resources, we find that the combination of Anderson and Christianson would not have suggested "in response to said insufficient resources detection, automatically identifying one predetermined server," as required by claim 10.

Because Appellant has shown the Examiner erred, we reverse the rejection of claim 10 as being unpatentable under 35 U.S.C. § 103(a) over Anderson in view of Christianson.

Claims 5, 16, and 22

As to claim 16, Appellant argues that that "[t]here is simply nothing in Warwick even remotely connected or connectable to a method of collecting data representative of a computer profile <u>for achieving an electronic business transaction</u>" and thus the Examiner's findings "shed no light onto how combining these three references would result in the subject matter of claim 16" (App. Br. 10). Appellant then contends that "there is no support to be found in any of the references for the Examiner's alleged motivation for the skilled person to combine Christianson, Anderson, and Warwick" (*id.*).

However, the Examiner finds that though "Anderson does not specifically disclose the profile parameters are collected by means of an interrogation via the DMI or WMI," "Warwick discloses WMI is one implementation of the Common Information Model schema for managing systems, networks, applications, databases and devices" (Ans. 12). Thus, the Examiner finds that it would have been obvious to combine the teachings

"because Warwick's teaching of WMI would obviate the need for developers to create private interfaces to kernel mode drives to access that information" (*id.*).

Accordingly, we determine in this Appeal whether Appellant has shown that the Examiner erred in finding that the combination of Anderson, Christianson, and Warwick teaches or would have suggested a method "of using DMI or WMI interfaces" (Claim 16).

In claim 16, the language "for collecting data representative of a computer profile" and "for electronic business transaction" are merely intended uses of the interfaces. We will not limit the scope of claim 16 by the intended use language because such statements merely define a context in which the invention operates. *See Boehringer*, 320 F.3d at 1345. In fact, claim 16 *in its entirety* is merely a preamble without any body which fully and intrinsically sets forth all of the limitations of the claimed invention. Intended use language in a preamble which merely recites the purpose or intended use of the claimed invention does not further limit the claim. *See Pitney Bowes, Inc.*, 182 F.3d at 1305; *see also Rowe v. Dror*, 112 F.3d at 478.

We conclude that the subject matter sought to be patented by Appellant as a whole would have been obvious to the artisan as we consider the facts of the case and the common sense of those skilled in the art. *See Leapfrog*, 485 F.3d at 1161.

Warwick discloses using WMI interfaces (FF 3). As the Examiner finds, "Warwick discloses WMI is one implementation of the Common

Information Model schema for managing systems, networks, applications, databases and devices" (Ans. 12) and thus, it would have been obvious to combine the teachings "because Warwick's teaching of WMI would obviate the need for developers to create private interfaces to kernel mode drives to access that information" (*id.*). We agree with the Examiner that Warwick, in combination with Anderson and Christianson, teaches or would have suggested a method "of using DMI or WMI interfaces," as required in claim 16.

Appellant has presented no evidence that adding the WMI interfaces for collecting data to the teachings of Anderson and Christianson of collecting data on the conventional Microsoft-based systems was "uniquely challenging or difficult for one of ordinary skill in the art" (*see Leapfrog*, 485 F.3d at 1162), nor has Appellant presented evidence that these "represented an unobvious step over the prior art" (*id.*). Rather, Appellant's claimed invention is simply an arrangement of the well-known teachings of applying WMI interfaces with the well-known teaching of collecting data on Microsoft-based systems. The combined teachings of the references represent merely a combination of familiar elements according to known methods and do no more than yield predictable results. *See KSR*, 550 U.S. at 416.

Consequently, Appellant has not met the burden of showing the Examiner erred in rejecting claim 16 and claims 5 and 22 falling therewith, under 35 U.S.C. § 103(a) over Anderson in view of Christianson and Warwick.

CONCLUSIONS

(1) Appellant has not shown that the Examiner erred in concluding that claims 1-4, 6-9, 11-15, 17-21, and 23-25 are unpatentable over the teachings of Anderson in view of Christianson.

(2) Appellant has shown that the Examiner erred in concluding that claim 10 is unpatentable over the teachings of Anderson in view of Christianson.

(3) Appellant has not shown that the Examiner erred in concluding that claims 5, 16, and 22 are unpatentable over the teachings of Anderson in view of Christianson and Warwick.

(4) Claims 1-9 and 11-25 are not patentable over the prior art of record.

DECISION

We affirm the Examiner's decision rejecting claims 1-9 and 11-25 under 35 U.S.C. § 103(a). We reverse the Examiner's decision rejecting claim 10 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED-IN-PART</u>

msc

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